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Date: September 20, 2005

To: Karin Ferriter
Office of Patent Legal Administration
United States Patent Office

Fax Number: 571-273-8300

From: David Halvorson

Pages: 4 (including this cover sheet)

Re: Patent Application of Cardy et al.
Application No.: 10/054,245
Filed: January 24, 2002

.....

Enclosed for filing and consideration in the above captioned case is our earlier email correspondence.

Halvorson, David

From: Halvorson, David
Sent: Tuesday, September 20, 2005 12:28 PM
To: 'karin.ferriter@uspto.gov'; 'kenneth.schor@uspto.gov'
Subject: RE: U.S. Patent Application Ser. No. 10/054,245 - alleged non-cooperative inventor Ken Rambo
Importance: High

September 20, 2005

RE: Patent Application of Cardy et al.
Application No.: 10/054,245
Filed: January 24, 2002
For: Telecommunications System Having Separate Switch Intelligence and Switch Fabric

Dear Sir/Madam:

On June 17, 2005, I wrote you regarding the above-referenced reexamination (see email below.) I have received no reply. However, on September 14, 2005, the U.S. Patent Office dismissed as moot the patent owner's petition requesting suspension of the rules apparently allowing this reexamination to move forward without consideration of the issues raised in my email. My email was not made part of the record and, apparently, was not considered in dismissing the petition. Obviously, I find this to be disappointing. I raised significant issues regarding whether the patent owner has acted in good faith and with candor before the United States Patent Office in pursuing this and its earlier petition.

If there is a more appropriate mechanism I should utilize to have the Patent Office address these issues, please let me know. In a telephone call with Mr. Schor on June 16, 2005, I was advised that writing to you was the most appropriate mechanism.. However, my correspondence was never responded to and it appears to have been totally ignored.

Very truly yours,

Very truly yours,

David Halvorson
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-----Original Message-----

From: Halvorson, David
Sent: Friday, June 17, 2005 11:51 AM
To: 'karin.ferriter@uspto.gov'; 'kenneth.schor@uspto.gov'
Subject: U.S. Patent Application Ser. No. 10/054,245 - alleged non-cooperative inventor Ken Rambo

June 17, 2005

RE: Patent Application of Cardy et al.
Application No.: 10/054,245

Filed: January 24, 2002

For: Telecommunications System Having Separate Switch Intelligence and Switch Fabric

Dear Sir/Madam:

I am writing to bring to your attention information that may be pertinent in the above-captioned case. I represent Qwest Communications International Inc. and its affiliated companies ("Qwest".) The issue involves Worldcom's libelous allegation of non-cooperation by one of the named inventors, Ken Rambo, in the above-captioned reissue application. Mr. Rambo was employed by WorldCom at the time of development of the alleged invention but later left WorldCom and started working for Qwest.

In order to determine the procedure, if any, for submitting this information, I contacted the U.S. Patent Office and was eventually directed to Mr. Schor. In a telephone conversation on June 16, 2005, Mr. Schor indicated that he would determine if and how he could accept the information Qwest would like to share based on the input and direction of Ms. Ferriter and suggested that I either email or call Ms. Ferriter. Thus, I am providing this email.

Worldcom, the patent owner in this reissue application, has now filed a total of three petitions related to the alleged "non-cooperation" of two named inventors in connection with this reissue proceeding. In its original petition filing, Worldcom indicated that it had contacted Mr. Rambo by telephone regarding this reissue but did not indicate they had attempted to deliver copies of the application papers to him. On July 31, 2002, the Patent Office correctly dismissed the petition to file the reissue without Mr. Rambo's signature stating that the petition lacked the required proof that the patent owner had, in fact, provided the application papers to the inventor.

Following the July 31, 2002 decision, Worldcom forwarded a package to Mr. Rambo. The package was marked "Worldcom Confidential". Mr. Rambo contacted my office for guidance because Qwest policy does not allow Qwest employees to accept unsolicited confidential information from third parties. I told Mr. Rambo he should return the package, without review, to Worldcom. In turn, I contacted counsel for WorldCom and told them that Mr. Rambo could not accept confidential documents from Worldcom. At the time, I was not informed or aware that the reissue application was already pending. Thus, I did not know that all documents that should have been presented to Mr. Rambo (i.e., the application papers) were already public. I did, however, tell counsel for Worldcom that clearly if they were going to proceed to file a reissue, the documents would become public almost immediately after Mr. Rambo signed them and, therefore, I did not see any need for them to be presented to Mr. Rambo on a confidential basis. The Worldcom attorney told me that he was simply acting at the instruction of his management but did not provide any other basis for requesting that Mr. Rambo accept this information on a confidential basis.

I then received correspondence from Worldcom arguing that Qwest was interfering in the contractual relationship between Mr. Rambo and Worldcom. Mr. Rambo had earlier allegedly signed an agreement with Worldcom that Worldcom argued provided for continuing obligations to "at any time execute any and all instruments and documents and do such further acts and things which the Company [Worldcom] may deem desirable" in connection with inventions created by Mr. Rambo while employed at Worldcom. I vigorously denied the allegation that Qwest was interfering in a contractual relationship between Mr. Rambo and Worldcom. Qwest was more than willing to allow Mr. Rambo to reasonably cooperate with Worldcom on this issue if Mr. Rambo was contractually obligated to do so. But, Worldcom did not (and could not) point to any contractual obligation requiring Mr. Rambo to accept confidential information from Worldcom after he left their employment. Worldcom's position of requiring Mr. Rambo to accept these documents on a confidential basis is especially puzzling now that we have determined that the documents that should have been provided to Mr. Rambo were, in fact, publicly available from the Patent Office at the time Worldcom was insisting they be presented to Mr. Rambo on a confidential basis.

As a side point, Worldcom argued that its employment agreement requires Mr. Rambo to execute "any and all" documents Worldcom may deem desirable in connection with its patents. Obviously, it is wrong of Worldcom to purport to require Mr. Rambo (or any of its employees) to execute any and all documents – even documents that may be factually wrong. However, such onerous language may explain how Worldcom has obtained the sole signature in this reissue application. Perhaps, they have counseled that inventor, who is understood to continue to be an employee of Worldcom, that any and all documents presented must be signed regardless of their truth.

Amazingly, only weeks after insisting Mr. Rambo accept these documents on a confidential basis, Worldcom filed a petition on January 3, 2003 with the U.S. Patent Office accusing Mr. Rambo of being uncooperative AND enclosing as Exhibit D the supposedly confidential cover letter (the "Exhibit D Letter") that was allegedly mailed to Mr. Rambo. Despite their insistence that Mr. Rambo keep their mailing confidential, Worldcom showed no hesitation to publicly file the same information in their effort to disparage Mr. Rambo by calling him "non-cooperative" in order to allow this reissue proceeding to continue without his signature. The Exhibit D Letter indicates the only enclosures with their package, delivered to Mr. Rambo labeled as "Worldcom Confidential", were publicly available documents from the reissue application. Interestingly, and in support of the factual correctness of what is stated in this email, the Exhibit

D Letter itself is labeled "Worldcom Confidential" despite being publicly filed by Worldcom. Thus, while WorldCom was unwilling to allow Mr. Rambo to receive this letter on a non-confidential basis in October and November of 2002, it made the document publicly available on January 3, 2003 as an exhibit to a petition in which Mr. Rambo is criticized as being uncooperative.

Worldcom filed Exhibits D and E in support of position they took in their January 3, 2003 petition that Mr. Rambo was being uncooperative (Exhibits D and E are letters they sent to Mr. Rambo.) However, they failed to file or mention my letter of October 31, 2002 which would have provided the United States Patent Office with some of the background I am now providing in this email. They also failed to file or mention my email of October 22, 2002 questioning their insistence on providing this information on a confidential basis. They further failed to mention a conversation between myself and two Worldcom attorneys on that same date in which I questioned their insistence that Mr. Rambo accept the correspondence from them on a confidential basis. It seems clear that the patent owner should act with candor and good faith by providing complete information when filing a petition with the United States Patent Office.

Ignoring what should have been presented in their petition, there should not have ever been a need for a petition. Worldcom should never have refused to allow Mr. Rambo to see these documents without his agreeing to keep them confidential. This appears to be a defiance of the spirit, if not the letter, of 37 CFR 1.47(a) which is interpreted by the Patent Office as requiring the patent owner to provide the application papers to the inventors. See, Decision on Petition in the above captioned case dated July 31, 2002 stating "A grantable petition under 37 CFR 1.47(a) requires: proof the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings.)"

After refusing to allow Mr. Rambo to see the documents except on a confidential basis, Worldcom should not have falsely filed a petition labeling Mr. Rambo as uncooperative. If anyone has been uncooperative, it is Worldcom. Any petition filed by Worldcom requesting this application be allowed to continue forward without Mr. Rambo's signature should be denied.

Ken Rambo was, and still is, fully willing to reasonably comply with any contractual obligation he may have with Worldcom requiring his cooperation in this matter. However, regardless of the onerous wording the Worldcom employment agreement, Mr. Rambo cannot be required to sign "any and all" documents presented to him. He should only be asked to sign truthful documents. Further, he should not be asked to accept any documents from Worldcom on a confidential basis. Worldcom has not pointed to any contractual obligation requiring Mr. Rambo to accept Worldcom confidential information on a confidential basis after he left employment of Worldcom. Further, the documents that Worldcom should have, and apparently did, send to Mr. Rambo were not confidential in any event despite Worldcom sending them to Mr. Rambo in an envelope marked as confidential which was returned to Worldcom unopened.

In addition to accusing Mr. Rambo of being uncooperative in its January 3, 2003 petition, Worldcom filed a petition on January 4, 2005 accusing Mr. Rambo of "refusing" to sign the earlier petition. Mr. Rambo could not possibly refuse to sign a document he was not allowed to review. Worldcom did not allow Mr. Rambo to review the document because of their insistence that he accept what we have now found out to have been public documents on a confidential basis. The January 4, 2005 petition remains pending.

I am more than willing to provide any additional information that might be helpful in this matter including copies of correspondence between myself and representatives of Worldcom.

Very truly yours,

David Halvorson
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